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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,969	08/26/2003	Peter Robert Ford	85939.000243	7080
23387	7590	07/27/2006	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/649,969	<b>Applicant(s)</b> FORD ET AL.	
	<b>Examiner</b> Alicia Chevalier	<b>Art Unit</b> 1772	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 60-85 is/are pending in the application.
- 4a) Of the above claim(s) 77-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 60-76 and 83-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **RESPONSE TO AMENDMENT**

1. Claims 1-5 and 60-85 are pending in the application, claims 77-82 are withdrawn from consideration. Claims 6-59 have cancelled.
2. Amendments to the claims, filed on August 3, 2005 and January 31, 2006, have been entered in the above-identified application.

Upon further consideration the species restriction between powder and particles is withdrawn, since they are considered to be similar. Therefore, the species powder will be considered with the particle species.

### ***Election/Restrictions***

3. Applicant's election of species 1, the particles/powder, in the reply filed on May 10, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

### ***REJECTIONS***

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 102***

5. Claims 1-5, 60-77 and 83-85 are rejected under 35 U.S.C. 102(e) as being anticipated by Willett (U.S. Patent No. 6,849,310).

Willett discloses a vehicle weatherseal (*col. 2, lines 54*) for reasably contacting a panel (*col. 2, lines 55-56*). The weatherseal comprising a panel contacting portion for releasably contacting the panel (*col. 2, lines 55-56*) and a retroreflective surface (*high gloss powder coating, col. 1, lines 65-67*) comprising retroreflective particles/powder (*col. 5, line 35*) on the panel contacting portion (*col. 5, lines 12-19 and figures 9-11*). For proposes of examination high gloss is considered to be retroreflective because they both reflect light brightly.

The multitude of retroreflective particles are friction reducing projections (*col. 2, line 2*). The panel contacting portion includes a substrate, the retroreflective surface is located on the substrate and the retroreflective surface has a lower coefficient of friction than the substrate (*col. 2, line 2 and figures 9-11*). The seal further comprises a plurality of surface roughness which are friction reducing particles (*col. 1, line 65 through col. 2, line 5*). The particles are embedded in at least a portion of an exposed surface panel contacting portion (*col. 6, lines 51-59*) and are deemed to be sufficiently distanced to preclude unintended separation from the panel contacting portion. The seal further comprising a bonding agent (*resin, col. 5, line 36*) intermediate a portion of the retroreflective particles and the panel contacting portion (*figures 9-11*).

The panel contacting portion is a thermoset material (*col. 3, lines 46-52*) and the powder coating comprises a thermoplastic or thermoset material (*col. 5, lines 59-67*). The seal further comprising a trim portion connected to the panel portion, the powder coating located on the trim

portion (*figures 9-11*). The seal further comprises a metallic reinforcing member connected to the panel contacting portion (*col. 3, lines 56-57 and figure 3*).

The limitations of claims 83-85 are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

6. Applicant's arguments in the response August 3, 2005 regarding the previous ground of rejection of record have been considered but are moot due to the new grounds of rejection.

#### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac  
7/21/06

  
ALICIA CHEVALIER  
PRIMARY EXAMINER